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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,433	02/19/2002	Michiharu Yamamoto	111996	2303
25944	7590	11/02/2004	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			IP, SIKYIN	
			ART UNIT	PAPER NUMBER
			1742	

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/076,433

Applicant(s)

YAMAMOTO ET AL.

Examiner

Sikyln Ip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 2,5-9,11,13-15,17,19-21,23 and 25-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,10,12,16,18,22,24 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

This application contains claim 2, 5-9, 11, 13-15, 17, 19-21, 23, 25-27, and 29 drawn to an invention nonelected with traverse in paper received July 19, 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant's election with traverse in the reply filed on July 19, 2004 is acknowledged. The traversal is on the ground(s) as set forth in instant remarks page 8. This is not found persuasive because the Groups of claims are in different classes and excluding from each other by the transitional expression "consisting of". Therefore searching all different groups of claims are serious burden to the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.3218 may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 4, 10, 12, 16, 18, 22, 24, and 28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 09/984,039 (U.S. Pub No.: US 2002/0090315). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed Ti-Cu alloy composition, grain size, and tensile properties are overlapped by claims of said copending application. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. The newly recited electrical conductivity would have been inherently possessed by the alloy of co-pending application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3, 4, 10, 12, 16, 18, 22, 24, and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The newly added limitation "an electrical conductivity of 13.2% IACS or more" is not supported by the specification as original filed. The phrase "or more" includes electrical conductivity ranges not supported by Tables 3-5 in instant specification.

Claim Objections

Claims 1, 3, 4, 10, 12, 16, 18, 22, 24, and 28 are objected to because of the following informalities: Applicants recite the Japanese Industrial Standard H 3110 in instant claim 1, for example, is improper for reason below. Appropriate correction is required.

The incorporation of essential material in the specification and claim by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Claim Rejections - 35 USC § 103

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3, 4, 10, 12, and 16 are rejected under 35 U.S.C. 103(a) as obvious over USP 4599119 to Ikushima et al in view of Nagarjuna et al or acknowledged prior art admission.

Ikushima disclose(s) the features including the claimed Ti-Cu alloy (col. 1, lines 35-58), grain size (col. 1, lines 60-63), hardness, tensile properties, and bending properties (Table 4, first 4 samples) except for the claimed electrical conductivity. Ikushima in col. 1, lines 15-18 discloses age-hardened Cu-Ti alloy has excellent electrical conductivity but does not disclose a numerical range of the electrical conductivity. Nagarjuna (abstract) and acknowledged prior art admission ([0008]) disclose electrical conductivity 25% and at least 10% IACS, respectively. Therefore, as shown by Nagarjuna that age-hardened Cu-Ti alloy would have electrical conductivity up to 25%. And electrical conductive materials as disclosed by cited references is required to be at least 10% IACS (See acknowledged prior art admission [0008]).

Claims 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 4599119 to Ikushima et al in view of Nagarjuna et al or acknowledged prior art admission as applied to claims above and further in view of Van Vlack.

The claimed subject matter as is disclosed and rejected above by the cited reference(s) except for the claimed tensile strength and hardness. However, Van Vlack in pages 187 and 189, Figures 6-5.1 and 6-6.2, (a)-(c), respectively, discloses cold work increases tensile strength and hardness and decreases elongation of Cu alloys in the

same field of endeavor or the analogous metallurgical art. Therefore, it would have been obvious to one having ordinary skill in the art of the cited references at the time the invention was made to compromise ductility/elongation for higher tensile properties and hardness in order to improve spring/elastic property. It has been well settled that selecting a range in a known range by optimization for the best results is within ambit of ordinary skill artisan, see *In re Aller*, et al., 105 USPQ 233 and *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). Moreover, optimization of a variable recognized in the art as a result-effective variable normally is considered to be within the ordinary skill of the art. See *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

The newly recited cold rolling reduction ratio 95% or more is noted. But, the invention defined in a product-by-process claim is a product, not a process. In *re Bridgeford*, 357 F. 2d 679, 149 USPQ 55 (CCPA 1966) and MPEP § 2113. It is the patentability of the product claimed and not of the recited process steps which must be established. See *In re Brown*, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972). The guidance that has been provided by court on this matter is

[i]f the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964, 966 (Fed. Cir. 1985). When applicant's and prior art's products are to be identical or substantially identical, the burden shifts to applicant to provide evidence that the prior art product does not inherently possess the claimed properties. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); *In re Fessmann*, 489 F.2d 742, 745 180 USPQ 324, 326 (CCPA 1974); and *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

Claims 22 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 4599119 to Ikushima et al in view of Nagarjuna et al or acknowledged prior art admission and Van Vlack as applied to claims 18 and 24 above, and further in view of USP 6585833 to Ordillas.

The claimed subject matter as is disclosed and rejected above by the cited reference(s) except for the fork shape connector. However, Ordillas in Figures 1 and 2 and col. 1, line 10 to col. 2, line 8 discloses the conventional fork shaped connectors are known to be made with Cu based alloy in the same field of endeavor or the analogous metallurgical art. Therefore, it is contemplated within ambit of ordinary skill artisan to use Cu based alloys to form conventional fork shape connector because of the spring property of Cu based alloy.

Response to Arguments

Applicant's arguments with respect to rejected claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore provide a concise explanation and support with page and line number in the specification for any amendments made to the disclosure. See 37 C.F.R. Part §41.37 (c)(1)(v).

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Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (571) 272-1241. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (571)-272-1244.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
October 18, 2004